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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,751	03/09/2004	Robert B. Huston	50838/518:3	4221

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EXAMINER

JOHNSON, STEPHEN

ART UNIT PAPER NUMBER

3641

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

CA

Office Action Summary

Application No.

10/797,751

Applicant(s)

HUSTON, ROBERT B.

Examiner

Stephen M. Johnson

Art Unit

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/9/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3641

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 34-35, 43, and 46-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The application as originally filed lacks support for the claim language directed to “a material that shrinks when molded to thereby generate a tension that pulls the breech portion and the muzzle portion toward each other” (claims 34 and 46) and “in which the tension is opposed by a compression force exerted on the sleeve” (claims 35 and 47). The application as originally filed lacks support for the claimed “the muzzle portion includes a minor bore and a major bore, the insert member inserted into the minor bore and the sleeve inserted into the major bore” (claim 43).

3. Claims 34-35, 43, and 46-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The application as originally filed lacks support for the claim language directed to “a material that shrinks when molded to thereby generate a tension that pulls the breech portion and the muzzle portion toward each other” (claims 34 and 46) and “in which the tension is opposed

Art Unit: 3641

by a compression force exerted on the sleeve” (claims 35 and 47). The application as originally filed lacks support for the claimed “the muzzle portion includes a minor bore and a major bore, the insert member inserted into the minor bore and the sleeve inserted into the major bore” (claim 43).

4. Claims 21-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21, line 4; and in claim 36, line 3; use of the phrase “thin-walled” makes the claim indefinite as to what thickness of the wall is required to meet this claim limitation. In claim 21, lines 2-3, applicant claims “a breech portion” and “a muzzle portion”. Portions of what are intended? These are clearly not portions of tubular sleeve 38 being composed of different materials and being structurally independent (18 breech portion) (30 muzzle portion). In claim 48, use of the phrase “light weight” makes the claim indefinite as to what weights are intended to be included or excluded by such relative terminology.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 21-26 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (912).

Smith (912) discloses a firearm barrel comprising:

a) a tubular sleeve;

Art Unit: 3641

- b) a breech portion; 22
- c) a muzzle portion; 20
- d) an elongated insert member; 12
- e) a casing; 16, 18 (outer portions)
- f) a moldable material that is a resin in combination with carbon fibers; col. 2, lines 52-61
- g) stems having serrations; 28, fig. 1

7. Claims 21-24, 26-27, 29, and 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Manshel.

Manshel discloses a firearm barrel comprising:

- a) a tubular sleeve; 4
- b) a breech portion; adjacent 11
- c) a muzzle portion; 12
- d) an elongated insert member; 1
- e) a casing; 6
- f) a moldable material that is a resin in combination with glass fibers; col. 2, lines 17-19
- g) breech stem having serrations; and adjacent 11 (fig. 1);
- h) muzzle portion stem having serrations. 12 (fig. 1)

8. Claims 21-22, 24-32, 36-42, and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Fournier.

Fournier discloses a tube barrel comprising:

Art Unit: 3641

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|---|----------------|
| a) a tubular sleeve; | 1, 2 |
| b) a breech portion; | 5 (adjacent 1) |
| c) a muzzle portion; | 5 (adjacent 2) |
| d) an elongated insert member; | 4, 4 |
| e) a casing; | 3 |
| f) breech stem having serrations; and | 5 (adjacent 1) |
| g) muzzle portion stem having serrations. | 5 (adjacent 2) |

9. Claims 21-32, 36-42, 44-45, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Werner.

Werner discloses a tube barrel comprising:

- | | |
|---|-------------------------|
| a) a tubular sleeve; | 34 |
| b) a breech portion; | 40 |
| c) a muzzle portion; | 28 |
| d) an elongated insert member; | 12 |
| e) a polymer casing; | 30; col. 3, lines 15-22 |
| f) breech stem having serrations; and | 40 (threaded portion) |
| g) muzzle portion stem having serrations. | 28 (threaded portion) |

10. Claims 34-35, 43, and 46-47 are too indefinite in their current form to make a determination regarding patentable subject matter.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Krumm et al. and Wicks disclose other state of the art gun barrels and/or tube barrels.

Art Unit: 3641

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Johnson whose telephone number is 703-306-4158.

The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 703-306-4198. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4177.



STEPHEN M. JOHNSON
PRIMARY EXAMINER

Stephen M. Johnson
Primary Examiner
Art Unit 3641

SMJ
March 28, 2005